

FALK & FISH

ROBERT HARDY FALK, P.C.
RONALD C. FISH, P.C.

G. BYRON JAMISON, SPECIAL COUNSEL

ATTORNEYS AND COUNSELORS
INTELLECTUAL PROPERTY LAW

ATTORNEYS AT LAW
A TEXAS LIMITED LIABILITY PARTNERSHIP

CHATEAU PLAZA
2515 MCKINNEY AVE, SUITE 1565
DALLAS, TEXAS 75201
TELEPHONE (214) 954-4400
FACSIMILE (214) 969-5941
Internet: <http://www.patent.net>
EMail: falk@patent.net

OFFICES IN DALLAS, TEXAS
AND SAN JOSE, CALIFORNIA

MAILING ADDRESS
P.O. BOX 794748
DALLAS, TEXAS 75379

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Fifth
Suppl
Statement
of Prior Art
1-30-01
L. Spruell

December 8, 2000

VIA FEDERAL EXPRESS

Examiner Stephen Funk
United States Patent and Trademark
Office Group 2854
Room 9D35- Crystal Plaza IV
Arlington, VA 22202

Re: United States Serial No. 09/315,796 to Davis and Williamson
Our File: WILL 2501

Dear Examiner Funk:

Enclosed please find an original of Reissue Applicants' **FIFTH SUPPLEMENTAL STATEMENT OF PRIOR ART AND OTHER INFORMATION**, which pertains to German Gebrauchsmuster G 93 05 552.8 (U1) registered in the Federal Republic of Germany in early June of 1993, and EP 620,115 to MAN-Roland Drucksmaschinen A.G., a counter-part to U.S. Patent No. 5,638,752 to Hartung, et al. which was the subject of Reissue Applicants' Third Supplemental Statement of Prior Art and Other Information. EP 620,115 was protested in the Federal Republic of Germany by German press manufacturer KVA. The instant binder contains Reissue Applicants' thoughts, the Gebrauchsmuster and its translation, two declarations of Expert Prince, and the file history of EP 620,115, including translations of the opposition portion of the file history.

Very truly yours,


Robert Hardy Falk

RHF:tsmc
Enclosure(s)

cc: William D. Harris, Jr., Esq. (w/encl.)

09/315,796

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:	§
BILL L. DAVIS and JESSE S. WILLIAMSON	§
	§
For Reissue of U.S. Patent 5,630,393	§ Group Art Unit:
Issued May 20, 1997	§ 2854
Serial No. 08/515,097	§
	§
Filing Date: May 20, 1999	§ Examiner:
	§ S. Funk
	§
Serial No: 09/315,796	§
	§
	§
For: COMBINED LITHOGRAPHIC/	§
FLEXOGRAPHIC PRINTING	§
APPARATUS AND PROCESS	§

**FIFTH SUPPLEMENTAL STATEMENT
OF PRIOR ART AND OTHER INFORMATION**

To: The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Reissue Applicants wish to bring to the attention of the Examiner (a) the claims of German Gebrauchsmuster G 93 05 552.8 (U1) (original German yellow Exhibit A hereto), registered June 3, 1993, said to be "laid open" July 15, 1993, and its translation (orange Exhibit B hereto), and (b) the file history of EP 620,115 to MAN-Roland Druchsmachinen A.G., related to U.S. Patent No. 5,638,752 to Hartung, et al. (the subject of Reissue Applicants' Third Supplemental Statement of Prior Art and Other Information, filed on or about September 26, 2000 incorporated herein), and the Opposition in the '115 file history by German opponent KVA, sustained at the Primary Opposition Board level on and references K1-K7 and translations as necessary cited by KVA in its opposition and supplemental opposition. A PTO-1449 form is attached.

I.

Gebrauchsmuster G93 05 552.8 (U1)

MAN-Roland Gebrauchsmuster G 93 05 552.8 (U1) was brought to Reissue Applicants' Assignee's attention on November 17, 2000. Apparently MAN-Roland in Germany filed two applications the same day in April 1993, the first cited in the EP 620,115

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file history (discussed below), and the second, a Gebrauchsmuster registration (sometimes called a "petty patent"). M.P.E.P. §901.05 (1995).

A.

The U.S. Law Concerning Gebrauchsmusters

Reissue Applicants contend that if Gebrauchsmuster ("GM") G 93 05 552.8 (U1) was indeed "laid open" July 15, 1993, only *its claims* are prior art against the Davis, et al. '363 patent, as opposed to the Gebrauchsmuster's specification and drawings. The is well "Gebrauchsmuster" settled law. Max Daetwyler Corp., et al v. Input Graphics, Inc., 583 F.Supp. 446, 455, 222 USPQ 150 (E.D. Pa. 1984); Permutit v. Wadham, et al., 13 F.2d 454, 456-457 (6th Cir. 1926); Reeves Bros., Inc. v. United States Laminating Corp., 282 F.Supp. 118, 136, 157 USPQ 235 (E.D. N.Y. 1968), aff'd, 412 F.2d 869, 163 USPQ 577 (2d Cir. 1969); Bendix Corp. v. Balax, Inc., et al., 421 F.2d 809, 812, 164 USPQ 485 (7th Cir. 1970). Again, Gebrauchsmusters cannot be used as references for the disclosure in their specification or drawings.

The reason that Reissue Applicants say "if" is that there is no proof that this GM was available as of July 15, 1993, or when. But for purposes of this section, Reissue Applicants will assume it was available by microfilm as of July 15, 1993 and reserve their evidentiary rights of objection.

The reason for this restriction is that Gebrauchsmusters are not "printed publications" at any time within the meaning of the statute. In re Tenney, 45 C.C.P.A. 894, 254 F.2d 619, 623-627, 117 USPQ 619 (C.C.P.A. 1958); Bendix, supra, 421 F.2d at 811-812 and cases listed therein; Reeves, supra, 282 F.Supp. at 134-135; Safety Gas Lights Co. v. Fischer Bros. & Corwin, 236 F. 955 (D. N.J. 1916). This is a well established body of law. See also M.P.E.P. §901.05(b) (1983).¹

¹ Standard Oil Co. v. Montedison S.p.A., 494 F. Supp. 370, 206 USPQ 676, 750 (D. Del. 1980), aff'd, 664 F.2d 356, 212 USPQ 327 (3d Cir. 1981) (foreign applications laid open to public are not printed); Carter Products v. Colgate Polmolive Co., 130 F.Supp. 557, 565-66, 104 USPQ 314 (D. Md. 1955), aff'd, 230 F.2d 855, 108 USPQ 383 (4th Cir. 1956); Ex parte Haller, 103 USPQ 332 (Pat. Off. Bd. App. 1953)

For 35 U.S.C. §102(b) foreign patent type documents have to be analyzed on a case by case basis to ascertain if the document (a) is a "patent" within the meaning of the law, (b) are printed, and (c) published.

In In re Tenney, et al., 254 F.2d 619, 117 USPQ (C.C.P.A. 1958), Chief Judge Johnson, speaking for a unanimous panel, reversed a decision of the PTO Board of Appeals and held that a Gebrauchsmuster was not a printed publication, citing Permutit, and wrestled with Congress' decision and the legislative history of various predecessor statutes prior to the 1952 Act's 35 U.S.C. §102(b) that foreign patents be both "printed" and published to be prior art.

"In our analysis of the basis of the 'printed publication' bar is corrected, numerous questions arise. *If it is prior 'accessibility' to the public of the subject matter of the invention that is the essence of the bar, why have the courts and the Patent Office consistently held that *900 a foreign typewritten patent application file which has been opened to public inspection in a foreign patent office is not a bar under the 'printed publication' provisions of the current and predecessor patent acts?* De Ferranti v. Westinghouse, Jr., 1890 C.D. 114 (Commr.Pats.); Parkin and Wright v. Jenness, 1893 C.D. 64 (Commr.Pats.) Bayer v. Rice, 1934 64 App.D.C. 107, 75 F.2d 238; Ex parte Haller, 103 USPQ 332 (Bd.Appls.1953); Carter Products, Inc. v. Colgate-Palmolive Col, D.C.D.Md.1955, 130 F.Supp. 557. *Why have the German Gebrauchsmuster, which are typewritten and open for public inspection, not been applied as statutory bars under the same provision?* [FN6] Permutit Co. v. Wadham, 6 Cir., 1926, 13 F.2d 454, rehearing denied, 6 Cir., 1926, 15 F.2d 20; Permutit Co. v. Graver Corp., 7 Cir. 1930, 43 F.2d 898; Ex parte Smith, 82, U.S.P.Q. 83 (Bd.Appls. 1941).

"FN6. It is to be noted that, inconsistently with these cases, typewritten college theses placed on library shelves have been held to be 'printed publications.' Ex parte Herschberger, 96 U.S.P.Q. 54 (Bd.Appls. 1952); Gulliksen v. Halber, 75 U.S.P.Q. 252 (Bd.Appls. 1937); Hamilton Laboratories v. Massengill, 6 Cir., 1940, 111 F.2d 584.

"It would seem that based upon pure logic alone, the foregoing means of accessibility to the public would be equally effective in vitiating the consideration necessary to support the patent grant as would be 'printed' publications. The answer to the foregoing questions, however, is not to be obtained by logical analysis, for as will hereinafter be shown, Congress' failure to cover this type of situation has unquestionably been due to legislative oversight or to some obscure policy not detectible on the face of the opinions considering the question nor in the volumes containing the legislative history of the 'printed publication' provision.

"It is clear, however, that the reason the foreign patent applications were not applied as bars by the courts is found in the requirement that the publication, to be a bar, must be 'printed.' [FN7]

"FN7. The earlier decisions did not urge this as the reason, De Ferranti, Parkin & Wrighty, Ulmann and Bayer v. Rice cases, supra, but the later decisions, in which the earlier were cited, made it unmistakably clear that the applications were not 'printed' and were, therefore, not printed publications, haller and Carter Products cases, supra."

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"But though the law has in mind the probability of public knowledge of the contents of the publication, the law does not go further and require that the probability must have become an actuality. *In other words, once it has been established that the item has been both printed and published, it is not necessary to further show *903 that any given number of people actually saw it or that any specific **627 number of copies have been circulated.* [FN9] The law sets up a conclusive presumption to the effect that the public has knowledge of the publication when a single printed copy is proved to have been so published. See Evans v. Eaton, 1818 3 Wheat. 454, 514, 4 L.Ed. 433; Curtis, Law of Patents, pp. 500-03 (4th ed. 1873)

"FN9. This statement, however, presupposes publication in fact. The so-called 'publication' cannot be a private communication or the like. Dow Chemical Co. v. Williamson Bros. Well Treating Corp., 10 Cir., 1936, 81 F.2d 495; see also Jockmus v. Leviton, 2 Cir., 1928, 28 F.2d 812.

"Using the foregoing as a guide, the answer to the instant question is clear. While microfilming furnishes a means of multiplying copies, there is no probability, from a mere showing that a microfilm copy of a disclosure has been produced, that the disclosure has achieved wide circulation and that, therefore, the public has knowledge of it. The nature of present day microfilm reproduction differs from normal printing methods. Though one would be more likely than not to produce a number of copies of printed material, one producing an item by microfilming would be as apt to make one copy as many. In the case of printing, unless a number of copies were produced, a waste of time, labor and materials would result; present day microfilming methods, on the other hand, are as well designed to produce one microfilm as well as many without waste.

"It is no doubt true that the present law is anomalous, as evidenced by our conclusion that the microfilm is not 'printed.' A foreign patent file, laid open for public inspection, is not a printed publication, because typewritten, while a printed publication, available to the public only in a Southern Rhodesian library, would be. The former is obviously more likely to reach the eyes of the American public than the latter. It is obvious, however, that unless we are to

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rewrite 35 U.S.C. 102(b) for Congress, this must be the result reached. Our job is to interpret the law, not to make it.

"For the foregoing reasons, the microfilm copy of the Karcher disclosure is not a 'printed publication' within the contemplation of section 102(b). Our conclusion that the microfilm is not 'printed' makes it unnecessary to consider whether it was published.

"In view of the concession that the claims must stand allowable if this reference is held to be of no legal effect, the decision of the board is reversed." (Emphasis supplied)

Chief Judge Johnson was joined by Judge O'Connell, Worley and Rich, Rich concurring.²

Under South Corporation v. United States, 690 F.2d 1368 (Fed. Cir. 1982), reissue applicants assert the Tenney and Nelson decisions concerning Gebrauchsmusters are the law of the land, and the rule of stare decisis:

² Judge Rich, twenty-three years later, held for another C.C.P.A. panel the "laid open" Australian application was prior art for its *entire* text. In re Wyer, 210 USPQ 790 C.C.P.A. (1981) (application microfilmed and deposited at five suboffices of the Australian Patent Office constitutes printed publication.) Judge Rich at no time compared the thoughts in his 1958 Tenney concurring opinion with his 1981 thoughts, stating that:

"While intent to make public, activity in disseminating information, production of a certain number of copies, and production by a method allowing production of a large number of copies may aid in determining whether an item may be termed a 'printed publication,' they are neither always conclusive nor requisite. Each case must be decided on the basis of its own facts. Accordingly, whether information is printed, handwritten, or on microfilm or a magnetic disc or tape, etc., the one who wishes to characterize the information, in whatever form it may be, as 'printed publication'

"... should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents. [Philips Electronic Corp., supra at 1171, 171 USPQ at 646]

"Through demonstration of the accessibility of reproductions of appellant's application in the Australian Patent Office and in each of its sub-offices, the PTO has met this burden." (Emphasis supplied)

210 USPQ at 795. *The Wyer panel, besides not expressly repudiating Tenney, distinguished Tenney on the grounds the GM microfilm was available in only one German office, while the Australian "laid open" publication was available in five.* As stated by the Northern District of Illinois, "It is an open question, which must be determined on the specific facts of each case, whether a foreign application that is available to the public is a printed publication under 35 U.S.C. §102(b)." Abbot Laboratories v. Diamedix Corp., 969 F.Supp. 1064, 1067 n.2, 43 USPQ2d 1448, 1450 n.2 (N.D. Ill. 1997). Note also Siemens-Elema AB v. Puritan-Bennett Corp., 13 USPQ2d 1804, 1806 (S.D. Calif. 1989) ("The application for the Swedish patent was available to the public upon request after February 3, 1969, which is more than a year before the application for the patent in suit was filed.") ; Scheller-Globe Corp. v. Milsco Mfg. Co., 206 USPQ 42 (E.D. Wis. 1979) *aff'd* 636 F.2d 177, 208 USPQ 553 (7th Cir. 1980) (prior art includes patentee's Belgian patent placed in public reading room and Netherlands patent application laid open to public inspection, both more than one year before applicant's effective filing date in the United States.) and In re Carlson, 983 F.2d 1032, 25 USPQ 1207 (Fed. Cir. 1992) (German *Geschmacksmuster* is a "patent" for purposes of 35 U.S.C. §102(a) and §102(b))

"The great principle, stare decisis, so fundamental in our law, and so congenial to liberty, is particularly important in popular governments, where the influence of passions is strong, the struggles for power are violent, the fluctuations of party are frequent, and the desire of suppressing opposition, or of gratifying revenge under the forms of law and by the agency of the courts, is constant and active.

Ex parte Bliman, 4 Cranch 75, 89, S. L. Ed. 554, 559 (1807)

Gebrauchsmusters are "petty patents", as registered, and are not subject to examination for inventive height/obviousness. Reeves. They can cover only articles, and not processes. Id. citing at 137, Nelson v. Wolf, 25 C.C.P.A. 1290, 97 F.2d 632 (C.C.P.A. 1938).

Some cases hold that the specification of a Gebrauchsmusters can be referred to in order to interpret the claims. Bendix, supra, 421 F.2d at 813-814; Max Daetwyler, supra, 583 F.Supp. at 455.

White Gebrauchsmusters are not publications, they are indexed, the index is published, and copies of the GMs are available to the public on request. General Tire and Rubber Co. v. Firestone Tire and Rubber Co., 349 F.Supp. 345, 355 (N. Ohio 1972), citing Permutit, supra, 13 F.2d at 458 and Bendix, supra, 421 F.2d at 811-812. Notice in the German patent Blatt (similar to a U.S. Patent and Trademark Office Gazette) of the registration of a Gebrauchsmusters is under U.S. law itself and is not a description in a "printed publication". Safety Gas Lighter Co. v. Fischer Bros. & Corwin, 236 F. 955 (D. N.J. 1916).

Finally, it is well settled that disclosure in foreign patented art, whether or not printed, are strictly construed and are restricted to what is clearly and definitely disclosed therein. National Latex Products Co. v. Sun Rubber Co., 274 F.2d 224, 236 (6th Cir. 1959); Morgan Construction co. v. Wellman-Seaver Morgan Co., 18 F.2d 395, 399 (6th Cir. 1927); General Tire and Ruber Co. v. Watson, 184 F.Supp. 344, 354 (D. D.C. 1960); General Tire and Rubber Co. v. Firestone Tire and Rubber Co., 349 F.Supp. 345, 357 (N.D. Ohio 1972).

B.

Claims 5-6 of GM '552

Reissue Applicants maintain that the only relevant claims of the Gebrauchsmusters G 93 05 552.08 (U1) are claims 5-6 bolded below, said to be dependent on claims 1-2 (which are end-of-press claims).

1. **Device preferably in sheet-fed rotary printing presses for multi-color offset printing for the coating of materials to be printed containing at least two lacquering stations whereby each lacquering station comprises one impression cylinder (8), one form cylinder (10), and one applicator roller (11, 14), and the lacquering station that is upstream with respect to the sheet running direction is configured as a flexographic stations (6).**
2. **Device according to claim 1 wherein the flexographic station (6) is equipped with an applicator roller (11), with which is associated an adjustable chamber doctor (12), whereby the applicator roller (11) is configured as an anilox roller.**
5. **Device according to claims 1 and 2 wherein the flexographic station (6) in an offset printing press is placed in between the printing stations (-15).**
6. **Device according to claims 1 and 2 wherein the flexographic station (6) in an offset printing press is placed upstream of the printing stations (1-5).**

C.

**Claims 5-6 of GM '552 Do Not Anticipate
or Make Obvious Any of the Pending Reissue Claims**

Reissue Applicants assert that Claims 5-6 of GM '552, Fig. 2 and the short supporting text clearly were derived from Jesse Williamson and his trip to MAN-Roland at the end of May 1992. See Reissue Applicants's Third Supplemental Statement of Prior Art and Other Information, filed September 26, 2000, and ¶11, Sixth Supplemental Declaration of Raymond J. Prince, light red Exhibit "C" hereto.

Prince points out in his Sixth Supplemental Declaration numerous disclosure difficulties of GM Claims 5-6, whether or not interpreted in view of the specification, and concludes that Claims 5-6 do not put Reissue Applicants' claimed invention in possession of the artisan, or made obvious said claimed invention:

"I further understand that Gebrauchsmusters are available as foreign patents under 35 U.S.C. §102(b) if timely available, and if the Gebrauchsmuster G 93 05 552.8 was available to be

ordered on July 15, 1993, its claims – and its claims only – would be prior art to U.S. Patent No. 5,630,363. I also understand that some case law exists in the United States that while the specification and drawings of Gebrauchsmuster G 93 05 552.8 are not available as prior art, under such case law one may use the specification and drawings to fairly interpret the meaning of any relevant German claims. I understand that processes cannot be claimed in German Gebrauchsmustern. *I have been asked to give my opinion if any of the claims of the Gebrauchsmuster meet the claim limitations of any of the claims of the pending reissue application or the issued '363 patent or put one of ordinary skill in the art in August 1995 in possession of the claimed invention of Claims 1-87 of the pending reissue application (Exhibit "F" hereto), or make the subject matter of these claims obvious to one of ordinary skill in the art.*

"I interpret Claims 1-4 and Claim 7 pertain to an article of manufacture ("device") with an end-of-press tower coater. I interpret Claims 5-6 as possibly referring to a device having an interstation or upstream tower coater. Of particular interest is the alternative of Claims 5 or 6 dependent on Claim 2, as opposed to Claim 1. I have reviewed Exhibit "A" and "B" [hereto to Prince's sixth declaration] and would like to make the following comments to the document, and specifically comment on Claims 5 and 6.

"For the reasons that follow, none of the proposed reissue Claims 1-87 nor the underlying claims of the '363 are fairly taught by Claims 5-6 of the Gebrauchsmuster, or are obvious to one of ordinary skill in the art in view of said Claims 5-6 of the Gebrauchsmuster, whether or not the specification is available for interpretation of the claims.

"First, the Gebrauchsmuster does not mention its application to the printing of metallic inks, and does not contain the text of the WIMS patent, U.S. Patent No. 5,370,976 to Doughty and Williamson, that would supply the motivation needed in the period of July 1993 - August 1995 for one to try going "up front" with a tower coater. The Gebrauchsmuster does not indicate the use of metallic inks in front of the lithographic unit.

"Second, no detail is made of flexographic inks or plates. Indeed, Claims 5-6 do not mention an expected advantage of printing metallic inks (increased brilliance) or any other advantage. In fact, the Gebrauchsmuster does not describe the use of flexographic plate for the purpose of printing dots in front of the lithographic units.

"Third, there is no mention of half-tone printing, only flood (possibly spot) coating of opaque whites. The Gebrauchsmuster (See Exhibits "A" and "B" [hereto]) does state the up front units will be used for printing opaque white. This is normally done for the reason of printing process color on metalized foil. What is done is to lay white and then print process color via lithography on top of the opaque white.

"Fourth, Claims 5-6 and the underlying specification do not teach, let alone mandate, interstation drying. In fact, the Gebrauchsmuster does not indicate how one would dry the flexographic ink prior to printing lithographic ink on top of it. The mention of drying in the last paragraph is simply insufficient. If attempted to be practiced on the opaque white mentioned in the Gebrauchsmuster, such a press containing an interstation flexographic tower would produce disastrous results - a mess. As applied by the device described in the Gebrauchsmuster, the process of Claim 5 or Claim 6 would be inoperable.

"With the foregoing difficulties, including the lack of a teaching equivalent to WIMS '976 and the lack of a sufficient teaching of interstation drying, the Gebrauchsmuster does not place Claims 1-87 of the pending reissue application in possession of one skilled in the art as of August 1995, let alone July 1993. Said another way, if one were to read the Gebrauchsmuster claims in July 1993 or August 1995, one of skilled graphic arts knowledge would not be in possession of the Davis-Williamson '363 invention." (Emphasis supplied)

For the reasons indicated, GM 93 05 552.8 (U1) does not bar the patentability of any of the claims undergoing reissue.

D.

**German Patent Agent, Lars Manke "Expert"
Report Does Not Alter the Tenney or Nelson Decisions**

Protester PRI recently filed an "expert" report by a German patent agent, Lars Manke, who was not even registered before the German Patent and Trademark Office when Gebrauchsmuster G 93 05 552.8 (U1) was ostensibly registered in June 1993. Manke is not a lawyer. Reissue Applicants object to his testimony as hearsay and to his status as an expert on German patent law. Manke has no personal knowledge of the handling of G 93 05 552.8 (U1) with the German Patent Office, or personal knowledge as to its availability to the public in 1993-1995.

Furthermore, Manke's declaration tells us nothing new.

1. The German Patent Gazette (Patentblatt) and the Unofficial Utility Model Bulletins are not Printed Publications Under U.S. Law

Manke first testifies:

"In general, German utility models (Gebrauchsmuster) are similar to German patents. Like German patents, a German utility model contains a description, claims and drawings (no abstract is required). The maximum lifetime of a German utility model is 10 years, instead of 20 years for a German patent. Further, the definition of "inventive step" is slightly different.

"Contrary to a German patent, a German utility model does not go through substantive examination but is registered upon passing the formal examination. Usually, the registration occurs between two and three month after the date of filing. The date of registration is published in the official PATENT GAZETTE (Patentblatt) and in the unofficial UTILITY MODEL BULLETIN (Auszüge aus den Gebrauchsmustern).

"The publication of the unofficial UTILITY MODEL BULLETIN occurs on the same day the registration of the utility model is published in the official PATENT GAZETTE.

"The publication of the registration of a German utility model in the official PATENT GAZETTE does not contain explicit details on the subject matter of the utility model; it shows the bibliographic data. The PATENT GAZETTE is the official publication of the German Patent and Trademark Office, and is printed by a publisher (Carl Heymanns Verlag) in Munich.

"The unofficial UTILITY MODEL BULLETIN is printed and published by another publisher (WILA Verlag) in Munich. The UTILITY MODEL BULLETIN contains more detailed information, i.e. a drawing and claim 1 of the respective utility model.

"Generally, both publications may be ordered directly from the publishers by any third party for whichever purposes. The PATENT GAZETTE is printed with a volume of approximately 700 copies per week, the UTILITY MODEL BULLETIN only with a volume of approximately 80 per week.

"The unofficial UTILITY MODEL BULLETIN is available to the public through at least the German Patent Office, through the 'Bayrische Staatsbibliothek' (German Library) in Frankfurt. Further, about 60 to 70 companies and law firms order the UTILITY MODEL BULLETIN for own inspection purposes.

"The official PATENT GAZETTE is available to the public through several universities and other institutions who order the PATENT GAZETTE for own inspection purposes."

Under Safety Gas Lighter Co., supra, neither the German Patent Office Gazette nor Utility Model Bulletin are printed publications.

We do agree with Manke that Gebrauchsmusters are "petty patents" with short lives, undergoing no substantive examination.

2. **Manke's Testimony as to Availability is
Hearsay Testimony on the Part of a Novice**

Manke next testifies:

"The German utility model G 93 05 552.8 with the German title "Einrichtung zum Inline-Beschichten von Bedruckstoffen in Offsetdruckmaschinen" (English title: "Device for in-line coating of printed materials in printing machines") has been filed on April 16, 1993. The date of registration was June 3, 1993. The registration has been published in the official PATENT GAZETTE and in the unofficial UTILITY MODEL BULLETIN on July 15, 1993.

"From the date of the registration (June 3, 1993) of the above German utility model, a list was available at the German Patent Office, on which the publication number, the main class and the date of registration of all German utility models are cited which have been registered at that day (June 3, 1993) including the publication number, the main class and the date of registration of the utility model in question.

"From the above date of registration, any third party had the opportunity to file a request for inspection of file for the utility model in question. This means, from the date of registration (June 3, 1993), any third party had the opportunity to get knowledge of the content of the above utility model in question.

"As already mentioned, the publication of the registration of a German utility model in the official PATENT GAZETTE and the unofficial UTILITY MODEL BULLETIN occurs a few weeks after the registration thereof. This date of the publication of the registration (June 3, 1993) was the day when the above utility model was open to the public and could be inspected by any third party. There is no printed copy of the German utility model, but is on microfiche. However, any third party had the opportunity to order a printed copy of the whole specification of the above utility model from the German Patent and Trademark Office." (Emphasis supplied)

Manke testifies about events in the German Patent Office three years before he was licensed to practice as a patent agent. He does not testify about how he personally could know when the file was "laid open".

Purported microfiche availability from a single German office is insufficient even if it were available. Tenney

3. Manke is Not a German Patent Law Expert

Manke finally states:

"The above declaration and any opinions herein are based on my knowledge of the German utility model law ("Gebrauchsmuster-gesetz"), my experience as a German patent attorney, my German patent practice, my knowledge of the German Patent Office and my knowledge of Carl Heymanns Verlag and WILA Verlag. I have not testified or given a deposition for the last four years.

"Attachments to this report are German utility model G 93 05 552.8, the mention of registration of the utility model in the PATENT GAZETTE and the unofficial UTILITY MODEL BULLETIN published July 15, 1993. It is expected that an English translation of the German utility model G 93 05 552.8 will be available in a supplement."

Four-year German agent associate Manke, from his resume, never attended law school, has obviously never tried a patent case in Germany, and became a partner at the agents' firm of Üekull & Stolberg since the inception of this suit. His testimony concerning G 93 05 552.8 is hearsay, and he is not qualified to testify as an expert under either U.S. law or German law. Manke's testimony is excluded under F.R. Ev. 602, 701, 802-803.

II.

The File History of EP 620,115, the KVA Opposition and Cited Art K1-K7

A.

EP 620,115 and the KVA Opposition

EP 620,115 is the counterpart of Hartung '752, but does not contain Fig. 2 of the '752 and has a shorter text. Expert Ray Prince has reviewed the file history and exhibits K1-K7 submitted by opposer KVA, and has provided his testimony in Fifth Supplemental Declaration, dark red Exhibit D hereto:

1. Device in a rotary printing press for multi-color offset printing for coating material to be printed with at least two varnishing units, wherein each varnishing unit has an impression cylinder (8), a forme cylinder (10) and an applicator roller (11, 14) and the varnishing unit arranged upstream corresponding to the sheet running direction is constructed as a flexo print unit (6), wherein the flexo print unit (6) consists of the following elements:

a relief form carrying forme cylinder (10.1) which is in contact with the impression cylinder (8.1), an applicator roller (11) with a raster structure, which is in contact with the forme cylinder (10.1) and a settable-on chamber doctor (12) which is connected with a feed pump for liquid feed and a suction pump for liquid return wherein directly or indirectly arranged after the flexo print unit (6) is a varnishing unit (7) and wherein in the varnishing unit (7) an applicator roller (14) is provided relative to which a metering roller (13) is arranged to form a common metering slot.

2. Device according to Claim 1, characterised in that the flexo print unit (6) is arranged in an offset printing press between the printing units (1-5).

4. Device according to Claim 1, characterised in that the flexo print unit (6) is arranged in an offset printing press subsequent to the printing units (15).

The file history of EP 620,115 is set forth in Exhibit E and contains Tabs 1-20, followed by Tabs K1-K7 for the KVA cited references:

K1 = copy from the magazine "Offsetpraxis", 3/1993, pages 12-15

K1a = Enlargement of an illustration of copy K1

K2 = US=A-5 176 077

K3 = Copy from the reference book: "Flexodruck von Abis Z⁴", Cover page, masthead, page 160

K4 = "Druckindustrie" 9001 ST. Gallen, No. 5, Mar. 11th 1993, "Nach Golde drängt, am Golde hängt doch alles . . .", Title page, masthead, pages 22 and 23

K5 = DE-A-4 122 990

K6 = EP-A-0 499 382

K7 = Magazine: "FlexoDruck", 2-93, pages 42-43, "Goldlackdruck löst Metall-Bronzierung ab⁵"

The Opposition portion of EP 620,115 (purple Exhibit E, Tabs 13-20) are translated. EP application 94103832.5 was filed on March 12, 1994 (Tab 1) to MAN-Roland and claimed priority based on G 93 05 552.8 (U1) (Tab 4). A second report followed on August 19, 1994 (Tab 6) after a first office action and response (Tab 7) and second office action and response (Tab 8), the four claims, as amended (Tab 10), and translated into French and English (Tab 11) were sent to publication (Tab 12) on March 13, 1997 and the EPO patent was granted as EP 620,115.

A KVA opposition was mailed on January 22, 1998 seeking to revoke EP 620,115 in its entirety, citing references K1-K3 (Tab 13). Applicant MAN-Roland responded and a letter exchange followed (Tab 14). After the opposition division gave its preliminary opinion (the opposition would probably be rejected), (Tab 15), Opponent KVA cited new art K4-K7 on April 27, 1999 (Tab 18) and made more arguments against Claim 1.

B.

EP 620,115 was Revoked

The Opposition Division, on August 25, 1999, decided to revoke EP 620,115 (purple Exhibit E, Tab 19). **The primary thrust was on examination of Claim 1 – directed to an end-of-press coater, rather than Claim 2-3, which were not emphasized by applicant:**

3. Inventive step

3.1 *In the opinion of the Opposition Division, the subject matter of the independent claim 1 does not contain any inventive step within the meaning of article 56 EPC.*

3.2 After careful examination of all documents involved in the opposition proceedings, the Opposition Division reaches the conclusion, in agreement with the opponent, that the document K1 (magazine: "Offsetpraxis") is to be seen as the closest related state of the art.

3.3 Documents K1, K1 a, K4, and K7:

3.3.1 Based on the agreeing opinion of both parties, the Opposition Division determines that the following feature of the contested claim 1 is already described in document K1:

"Device in a rotary printing press for multi-color offset printing for coating materials to be printed with at least two coating units, whereby each coating unit comprises one impression cylinder (8), one form cylinder (10), and one applicator roller (11, 14), and the coating unit, upstream with respect to the sheet running direction ... is constructed, whereby ... a coating unit (7) is arranged directly or indirectly downstream, and whereby in the coating unit (7) an applicator roller (14) is provided, which is associated with an adjustable metering roller (13) to form a common metering slot."

The opponent could give prima facie evidence, that the multi-color offset rotary printing press "Filrffarben Roland 700", which is illustrated explicitly in the document K1, e.g. by means of a schematic drawing on page 13, also see document K1 a, and which was presented to experts during the course, of a so called presentation in the Druckerei Busche in Dortmund (DE), contained two coating units, both of which were constructed with one form cylinder and a double-roller unit as a metering system for coating.

The same special embodiment of the presented printing press is seen in the schematic drawing in document K4.

3.3.2 Contrary to the argument by the proprietor, in addition to this, the document K1 discloses to a person skilled in the art the following, additional features of the contested claim 1:

"... the coating unit, upstream with respect to the sheet running direction, is executed as a flexo print unit, whereby the flexo print unit consists of the following elements:

a relief form carrying form cylinder (10.1), which is in contact with the impression cylinder, an applicator roller (11) with raster structure, which is in contact with the form cylinder (10.1), and an adjustable doctor blade chamber (12) ... whereby a coating unit (7) is located downstream of the flexo print unit ...

Even if the actually presented multi-color offset printing press did not possess a coating tower with flexo printing plate and doctor blade chamber, every person skilled in the art can learn explicitly from the text of each of the submitted documents K1, K4, and K7, that it is possible to apply a special gold- or silver printing ink, which is based on an aqueous fixing agent or is water-soluble, onto a material to be printed by means of a flexo printing plate, see for example document K1, page 13, left column, second paragraph - page 14, right column, document K4, page 22, right column, penultimate paragraph - page 23, right column line 4, as well as document K7, page 42, left column, first paragraph, middle column, second paragraph, and page 43, middle column - first paragraph.

3.3.3 In addition, each of the documents K1 and K7 describes a doctor blade chamber system with anilox roller as an ink feed system for the plate cylinder that is equipped with a flexo printing plate. In particular from Document K7, a person skilled in the art obtains the statement that the final version of the presented multicolor offset printing press will comprise an anilox roller and a doctor blade chamber system, which was not installed in the actually presented machine only due to time limitations, see document K7, page 43, middle column, first paragraph. Document K4 only discloses a short inking attachment with anilox roller.

3.3.4 Both documents K1 and K4 directly and unambiguously state that at first the gold- or silver printing ink on a water basis is applied to the material to be printed by flexo printing, and only afterwards, i.e. downstream in sheet running direction, a conventional coating unit, i.e. e.g. as installed in the presented printing press, is used to apply a so-called overprint coating or dispersion coating, see for example document K1, page 14, middle column, last paragraph, and document K4, page 22, right column, penultimate paragraph, and page 23, left column, second paragraph, and right column - first paragraph. Document K7 does not state anything relevant to this matter.

3.3.5 In consideration of the arguments presented by both parties, the subject matter of the independent claim 1 is different from the technical teaching of document K1 only in the following features:

(a) "...doctor blade chamber (12), which is connected with a feed pump for liquid feed and with a suction pump for liquid return ..."

3.4 Thus, the published state of the art defines the problem of enabling the inline processing of quickly-evaporating, aqueous printing inks or printing coats with high

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pigment content or rough pigments in a simple manner, see patent specification, column 1, lines 47-51.

3.5 Based on the disclosure of document K1 illustrated above, the Opposition Division sides with the opinion of the opponent, that the object of the disputed patent is to improve the per se known doctor blade chamber system with anilox roller in such a way, so that a problem free transport of aforesaid special printing inks or printing coats can take place within the per se known doctor blade chamber system of a per se known flexo print unit within a multi-color offset rotary printing press.

3.6 Documents K2 and K6:

3.6.1 Both, the document K2, see e.g. column 2, lines 22-38, column 8, lines 37-52 and figures 1 and 2, and the document K6, see e.g. column 2, lines 3 -10, column 7, line 42 - column 8, line 14, and figures 1 and 2, not only clearly and directly described the feature (a) of the contested claim 1, which was mentioned above in item II 3.3.5, but also the exact reason why a feed pump is provided for liquid feed, and a suction pump is provided for liquid return. Both of the known devices must be suitable for the problem-free transport of aqueous, quickly evaporating flexo printing inks, whereby document K6 explicitly names pigment particles in inks or coatings of that type.

3.6.2 In view of the above mentioned object it is evidently obvious for a person skilled in the art to either install the ink pumps according to document K2, or the ink pumps according to document K6, into the doctor blade chamber system according to document K1, since he can learn from each of the two documents K2 and K6 independently how the aforesaid special problematic printing inks can be transported problem-free within the doctor blade chamber system. Hereby it is irrelevant for the present definition of the object, whether one deals with a pure flexo printing press without reference to an offset printing press as in document K6, or, as in document K2, with a flexo printing plate cylinder with the added function of a sheet transport cylinder or a type of satellite printing unit with respect to the counter pressure cylinder "(36)" of figures 1 and 2 of K2. Contrary to the arguments of the proprietor, the Opposition Division can not see how a person skilled in the art could be led away from the contested invention by the technical teaching of the documents K2 or K6. Through the identical problem definition in K2 and in K6 with respect to the stated problem definition of the disputed patent, the person skilled in the art almost receives a direct tip to install the ink pumps described in K2 and K6 to solve his task in the doctor blade chamber system inside a multi-color offset printing press of document K1.

3.6.3 *Thus, the subject matter of the contested claim 1 follows in a manner that is obvious to a person skilled in the art.*

3.7 Thus, the Opposition Division reaches the conclusion, that the subject matter of the independent claim I of the

disputed patent with respect to the published state of the art, in particular with respect to a combination of the document K1, combined either with the document K2 or combined with the document K6, does contain no inventive step in the sense of article 56 EPC.

3.8 The Opposition Division considers the remaining documents K3 and K5 mentioned in the course of the opposition proceedings as less relevant for the assessment of an inventive step, and cannot show a lack of an inventive step of the independent claim 1 by either considering each of the documents on its own, or by considering them in any combinations with each other, or with the other documents K1, K2, K4, K6, and K6, which were mentioned in the opposition proceedings.

3.9 Dependent claims 2-4:

In view of the present lack of an inventive step of the independent claim 1, and the fact that no motion by the proprietor is at hand to include any features of any dependent claim into the independent claim, there exists no need for a careful examination of the inventive steps of the claims 2 - 4 in question.

6. The opponent and the proprietor were given the opportunity to express their opinion in the sense of article 113 (1) EPC with respect to all grounds on which the present decision is based.
7. Since the independent Claim 1 in the granted version of the disputed European patent No. 0 620 115 does not meet the requirements of articles 52 and 56 EPC (Inventive step), due to the above mentioned grounds, the European patent had to be revoked in the sense of article 102(l) EPC. (Emphasis supplied)

Reissue Applicants will not comment here about the propriety under U.S. law of combining K1, K2, K4, K6 and K7 under 35 U.S.C. §103 to render an equivalent claim unpatentable. However, it is clear that neither the opponent KVA, Applicant MAN-Roland, nor the Board put any emphasis on any of the dependent claims. MAN-Roland rose or fell on Claim 1, covering their Roland 700 press.

C.

Prior Art K1-K7 is Immaterial to the '363

Reissue Applicants took the opportunity of having expert Prince review K1-K7, and where necessary, translations thereof, and Prince concluded (Fifth Supplemental Declaration, dark red Exhibit D) that K1-K7 did not teach the Davis/Williamson '363 process or make same obvious:

- "2. I have had the opportunity to review translations of the opposition portion of the file history of EP 630,115, the counterpart of Hartung et al., U.S. Patent No. 5,638,752, the subject of the testimony of one of my previously filed declarations. *In particular, I note Tab 19 of the '115 prosecution history and the August 25, 1999 Decision of the European Patent Office to revoke the '115 patent, and in particular 3.3.4 of that decision regarding dependant claims 2-4.* I have read each of references K1-K7 listed at page 4 of the English translation of the Decision, giving special emphasis to K1 and K4.
- "3. None of references K1-K7 teach the use of flexography "up front" for a lithographic press as taught or claimed in the Davis and Williamson '363 patent.
- "(a) with respect to the German "Offsetpraxis" trade article "K1" (translation) published March 1993, the article states unequivocally that coating is after the printing (paragraph 1, translation). **All that is described is a prototype MAN-Roland Model 700 press with a double tower coater end-of-press, which model commenced to be sold to the public in September 1993 with the IPEX Exhibition.**
- "(b) With respect to "Druckindustrie" K4, the article says (translation) "They demonstrated the inline-printing of gold using a relief process, subsequent to multi-colored offset printing. This abolishes the need for offline-bronzing." **Such a teaching eschews the method of the Davis and Williamson '363 patent.**
- "4. **None of references K2, K3 or K5-K7 teach the '363 patent process either.** K2 is the first of the DeMoore et al. "EZ" coater patents, which pertains to a cartridge coater end-of-press. This was a failed device commercially. K3 is a German dictionary with acceptable definitions; K5 is the Michael Huber (München) patent which is a teaching for a two-part water dilutable gold ink, possibly a flexographic ink. K6 pertains to a method of keeping an even pressure of a doctor blade on an anilox roller. Neat invention if it works! K7 is the early 1993 press release, like K1, for MAN-Roland 700 prototype machine with a double tower coater.
- "5. **I have read the translation of EP 620,115, which is even shorter than its U.S. counterpart, U.S. Patent No. 5,638,752. It does not enable one of ordinary skill in the art to practice the '363 process.** It even leaves out Fig. 2 of the '752 patent. Like the '752, it also left out the embodiments in U.S. Patent No. 5,476,042, based on the July 22, 1993 German patent application 43 24 631.1

In a nutshell, EP 620,115, the combined teaching of K1-K7 put someone into possession, if at all of the MAN-Roland Model 700 machine marketed at the IPEX Exhibition September 1993, the press announcement in 1993 concerning same, and some information concerning chambered doctors and anilox rollers.

A suitable PTO-1449 form is attached for GM 93 05 552.8 (U1), EP 620,115 and K1-K7.

III.

**The Claims of the Pending
Reissue Application are Allowable Under
35 U.S.C. §103 Over Claim 5-6 of the Gebrauchsmuster, Alone on in
Combination with the Entire Text and the Other References of Record**

The G 93 05 552.8 article claims by definition cannot anticipate Reissue Applicants' *process* claims. Moreover, Gebrauchsmuster G 93 05 552.8 (U1) *article* Claims 5-6 and its supporting text fail to mention in 1993 metallic inks, interstation drying or why the artisan would want to have a flexographic coater up front to solve any particular problem. Besides being inoperable in view of the lack of an adequate teaching of interstation drying, Fig. 2 and the brief mention of "up front" deployment of a coating tower seem to be an afterthought. Lacking the mention of a problem to be solved, the artisan would simply ignore the language on page 4 of the specification, Fig. 2, Claims 5-6 and move on.

In view of the foregoing inoperability and lack of enablement problems, compounded by the law narrowly construing foreign patents, the reissue claims are seen as being clearly allowable over the 1993 Gebrauchsmuster.

Respectfully submitted,



Robert Hardy Falk
Registration No. 27,877
FALK & FISH, L.L.P.
A Texas Limited Liability Partnership
P.O. Box 794748
Dallas, Texas 75397
Telephone: (214) 954-4400
Facsimile: (214) 969-5941

ATTORNEY FOR PETITIONERS BILL L.
DAVIS AND JESSE S. WILLIAMSON

CERTIFICATE OF SERVICE

This is to certify that the foregoing Reissue Applicants' Fifth Supplemental Statement of Prior Art and Other Information was served on '363 Protestors' and '713 Patentees' counsel of record via hand delivery on the 8th day of December, 2000, addressed as follows:

William D. Harris, Jr.
LOCKE LIDDELL & SAPP, LLP
2200 Ross Ave., Suite 2200
Dallas, Texas 75201


Robert Hardy Falk

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